

response to these arguments, the Examiner averred that "would each and every embodiment provide an unexpected result commensurate in scope with [the claims]". See, page 9 of the Final Office Action of July 31, 2002. Thus, as conceded by the Examiner, the unexpected results are in commensurate with at least certain embodiments, for example, claim 40.

Applicant respectfully points out that the specification contains specific teachings related to the unexpected results. See specification, for example, at page 15, lines 7-29 teaching that "[i]n order to verify the correction of the tyrosinase gene at the DNA level, genomic DNA was isolated from the same DOPA positive and negative skin biopsies from seven treated mice ... Surprisingly, a high level of gene correction approaching 40% was observed from skin biopsy of animal, in which RDO was injected intradermally or topically applied." The text at page 38, lines 6-15 teach that skin biopsies were taken 6-8 h after in vivo delivery of the RDO was carried out. Further, the statement that "[s]urprisingly, a high level of gene correction approaching 40% was observed" means that one skilled in the art would not have expected the level gene correction that was realized. *In re Soni*, 34 USPQ2d 1684 (Fed. Cir. 1995).

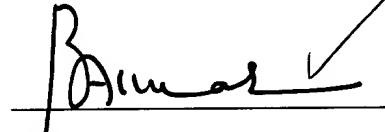
Furthermore, it is that the specification not the claims should contain specific data supporting the advantages of the claimed invention. *In re Soni*; See also the Examiner's notation on page 8 of the Final Office Action of July 31, 2002. This is true even of the unexpected advantages that an Applicant may rely upon to rebut a *prima facie* case of obviousness. *In re Soni*, 34 U.S.P.Q. 2d 1684 (Fed. Cir. 1995); *In re Chupp*, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987); and *In re Albrecht*, 185 U.S.P.Q. 585 (CCPA 1975). In each case, the claims described only the composition. In each case, the applicant relied upon unexpected advantages to rebut a *prima facie* case of obviousness. In each case, the advantages were not mentioned in the claims. In each case, the courts found the claims to be patentable. In this application, as in the above cited cases, the Applicant has relied upon unexpected advantages to demonstrate the nonobviousness of the claims. The Examiner may not refuse to consider this evidence, simply because those advantages are not recited in the claims. Therefore, the showing of the advantages of the claimed invention in the Applicant's specification is sufficient and is commensurate in scope with the present claims.

Accordingly, Applicant respectfully deems the claims rejections have been overcome and requests their reconsideration and withdrawal.

Applicant believes that this amendment places the application in condition for immediate allowance. Reconsideration and the early issuance of a Notice of Allowance are earnestly requested.

Date: January 31, 2003

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "W. McNichol", is written over a horizontal line. A long, thin diagonal line extends from the top right of the signature towards the upper right corner of the page.

William J. McNichol, Jr.
Registration No. 31,179
Nanda P.B.A. Kumar
Registration No. 44,853
Attorneys for Applicant

REED SMITH LLP
2500 One Liberty Place
1650 Market Street
Philadelphia, Pennsylvania 19103-7301
Fax: (215) 241-7945
Attn: William J. McNichol, Jr., Esq.
(215 241-7950)
Nanda P.B.A. Kumar, Esq.
(215 241-7991)

Marked Up Version of Claims in Serial No. 09/473,872

40. (Thrice Amended) A method of correcting a mutation in a tyrosinase gene in cells of a mammalian skin in vivo which comprises delivering to said cells at one or more locations of the mammalian skin an effective amount of a composition comprising a Tyr-A RNA-DNA oligonucleotide for causing stable genetic correction in the tyrosinase gene and a pharmaceutically acceptable carrier such that the correction results in restoration of tyrosinase enzyme activity [lasting beyond natural life span of differentiated epidermal cells] at said locations of the mammalian skin, wherein the mammalian skin is selected from the group consisting of a human and a mouse.